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10/697,274	10/31/2003	Abigail Jane Sellen	300201154-1	9201

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FORT COLLINS, CO 80527-2400

EXAMINER

LIE, ANGELA M

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,274

Applicant(s)

SELLEN ET AL.

Examiner

Angela M. Lie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 and 32-36 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. In the last paragraph of claims 1, 32, 35, 36 and 37, the applicant states the compilation takes place so that subset of messages having a form of human-readable document is created. The examiner would like to note that the messages obtained for instance from the email database are already in the human readable form, once the program opens the multiple messages, the viewer has the subset of the messages. This in fact makes the last step (last paragraph of above listed claims) redundant and therefore the utility of this invention does not exist. Compilation was not defined in the specification and therefore word compilation according to the general interpretation means "putting elements together", wherein opening multiple windows with the messages at the same time can also be considered to read on this limitation.

With respect to claims 32-34, the applicant claims a computer program executable; this in fact would not be possible unless this particular computer program would be installed on the device that could make operable.

With respect to claim 35, the applicant claims a computer program stored on a data carrier which is un-statutory because data carrier is considered to be a wave, and this does not make the program executable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 6, 10, 12, 22, 32, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Chappelle (US Patent 5949976).

As to claims 1, 32, 35 and 36, Chappelle discloses an apparatus for processing digital messages, comprising: input means arranged to receive input specifying an interrogation criterion (column 7, lines 35-37; inherently in order to search for predetermined information, the searching criteria or keyword has to be specified); interrogation means arranged to interrogate a database of digital messages sent to a user, to produce a subset of messages in accordance with the interrogation criterion (column 7, lines 35-41, in line 38, Chappelle mentions plurality of electronic messages) ; and compilation means arranged to produce a compilation of the subset of messages of having the form of a human-readable document (column 7, lines 50-52).

Note: With respect to claim 36, the central collection system is considered to be a server because it satisfies the definition: A high-power computer that is used to store and distribute data and/or applications.

As to claim 3, Chappelle discloses an apparatus wherein content of the messages is of a type selected from a group comprising: e-mail messages; data files attached to e-mail messages; images; multimedia clips (column 7, lines 37-38; the modification is made to emails, therefore the emails have to be result of the search).

As to claim 4, Chappelle discloses an apparatus wherein the database is a messaging server (column 7, lines 25-28; wherein web server is considered to be a messaging server, i.e. it stores the collection of messages which can be accessed from the remote computers as shown in figure 2).

As to claim 6, Chappelle discloses an apparatus wherein the interrogation means are configured to employ artificial intelligence algorithms when producing a subset of messages (wherein the algorithm for performing text file scanning is considered to employ artificial intelligence because it is a machine with embedded software that determines if the text matches the search criteria).

As to claim 10, Chappelle discloses the apparatus further operable to save the compilation in a data file (column 7, lines 60-63).

As to claim 12, Chappelle discloses the apparatus further operable to store the compilation in the database (column 7, lines 60-63).

As to claim 22, Chappelle discloses the apparatus wherein the digital messages are instant messages, and wherein the apparatus further comprises a database on

which the instant messages are stored when sent and/or received (column 3, lines 16-22, wherein e-mail is considered to be an instance of Instant Messenger, i.e. user's engaged in the conversation can send electronic messages back and forth, furthermore all of the e-mail supporting software allows to save emails at least until the mailbox reaches its maximum capacity. Chappelle's teaches the software, which uses email messages, therefore he also inherently teaches the software which is at least capable of receiving the messages).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 37 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) in the view of Kawell, JR. et al (US Publication 2005/0165726).

As to claims 2 and 37, Chappelle teaches all the limitation disclosed in the claim 1, he does not however, specifically point out that the graphical representation is a scrapbook. Kawell teaches organizing collections of digital information into scrapbook (paragraph 29), journal or photo-album. It would have been obvious to one of the ordinary skill in the art during the time the invention was made to incorporate Kawell's idea into the Chappelle's invention and have a graphical representation of a scrapbook

because it is well known in the art that the graphical representation of the file can be easily modified. It is a design choice, often dictated by the purpose of use or design criteria. Furthermore the scrapbook is nothing else than the graphical representation of a file.

As to claim 42, Chappelle discloses an apparatus wherein the interrogation means are configured to employ artificial intelligence algorithms when producing a subset of messages (wherein the algorithm for performing text file scanning is considered to employ artificial intelligence because it is a machine with embedded software that determines if the text matches the search criteria).

7. Claims 5, 11, 15, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) in the view of Microsoft Office Outlook.

As to claims 5 and 25, Chappelle teaches all the limitations as disclosed in claim 3, he does not however explicitly teaches that the input means are operable to receive the interrogation criterion from the user's e-mail (instant messaging) client application. Microsoft Office Outlook software shows that the criteria search from the user's client application has been in use for long period of time starting from Outlook 97 (Search criteria prompt as shown in figure 1 below). It would have been obvious to one of the ordinary skill in the art during the time the invention was made to use e-mail application to place the search criteria for searching relevant e-mail messages because the main application that deals with the email retrieving is an e-mail application for instance

Microsoft Outlook and therefore it would have been obvious to have all those options in one program (as it is already done).

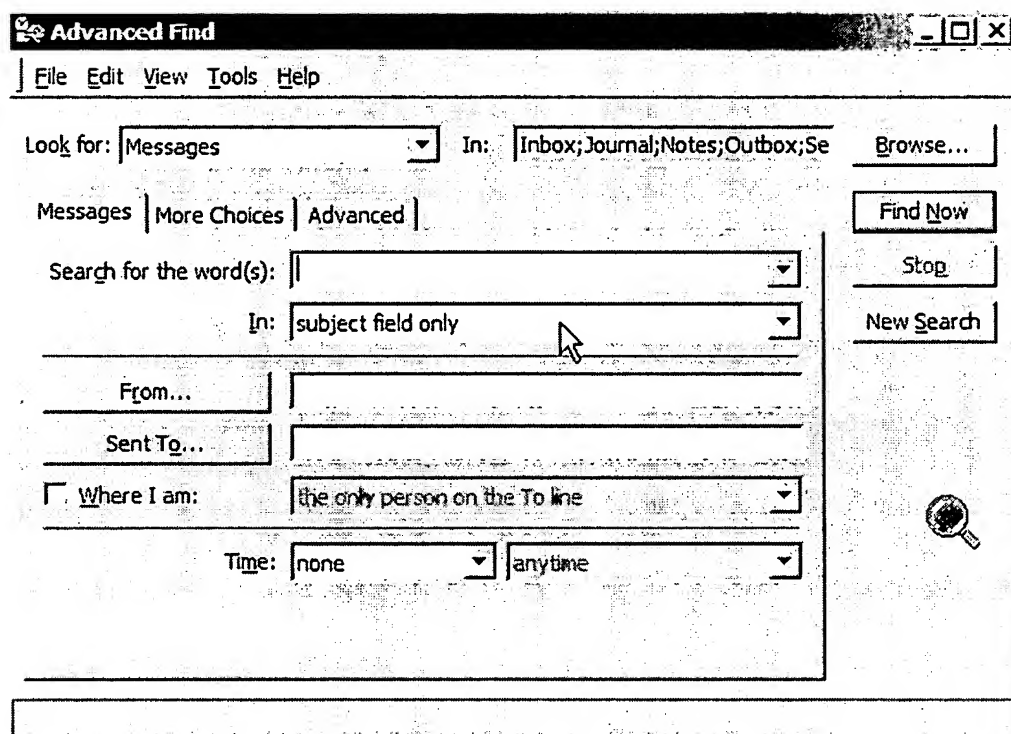


Figure 1

As to claim 11, Chappalle teaches all the limitations disclosed in claim 10, except for storing the compilation within the user's e-mail client application. Microsoft Outlook has a feature that allows the user to save search (wherein the result is considered to be a compilation of messages) in the e-mail application (as shown in figure 2 below). It would have been obvious to one of the ordinary skill in the art during the time the invention was made to store the result of the search, i.e. compilation inside the e-mail application because it would be a very convenient and fast solution for saving all the relevant messages, since a user would not need to save the file outside the e-mail

application and increase possibility of corrupting a file by undertaking incorrect steps in saving it.

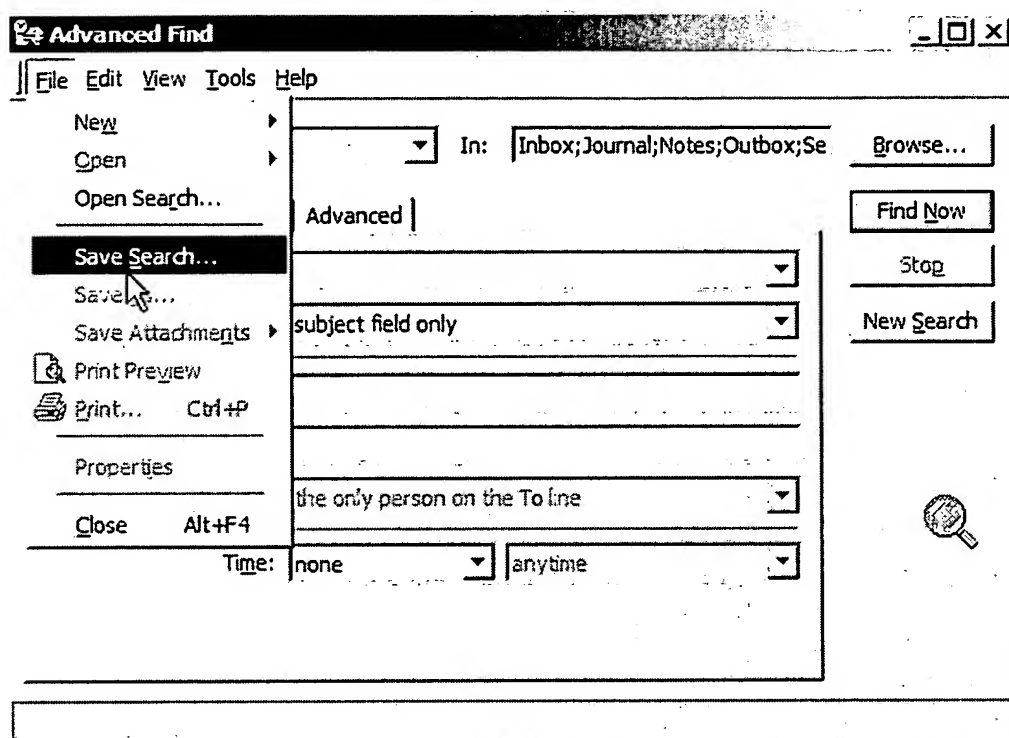


Figure 2

As to claim 15, Microsoft Outlook has a feature where the input means are operable to receive the interrogation criterion from a mobile station (outlook can be opened on laptop where a user can enter a keyword).

As to claim 27, Chappelle teaches all the limitations disclosed in claim 1, however he does not teach the compilation means being operable to arrange a sequence of the digital messages in the compilation according to a sequencing criterion specified by the user selected from a group comprising: chronological order; quantity of content; identity of sender; subject matter. The Microsoft Outlook has a feature that

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allows searching the email database and compiles the data into a chronological order (as shown in figure 3 below). It would have been obvious to one of the ordinary skill in the art during the time the invention was made to have the result compiled in the chronological order as shown in Outlook, because organizing messages and pacing them in the order for instance chronological makes it easier for the user to find out the order in which dialog was carried on.

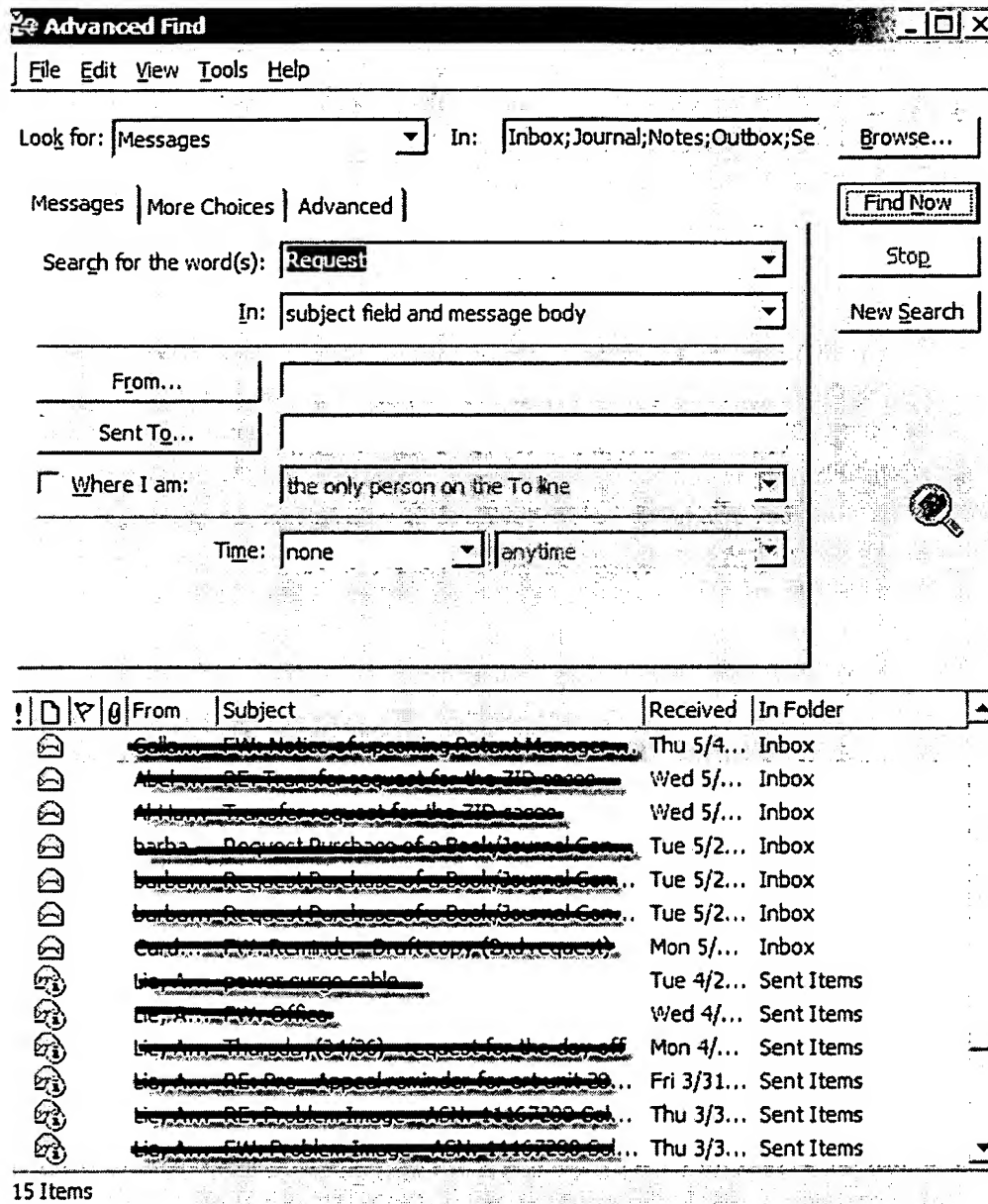


Figure 3

As to claim 28, Microsoft Outlook allows the compilation means being operable to adjust a level of detail of the digital communication presented in the compilation

according to a criterion specified by the user (as shown in the figure 3 above, a user can select additional options (criteria) according to which the search is going to be conducted and as a result of this search, compilation of the matched results will also be different).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) in the view of Rios et al (US Publication 2002/0194162).

Chappelle teaches all the limitations disclosed in claim 6, he does not teach however the compilation means being operable to remove duplicated content from messages for inclusion in the subset. Rios teaches a method and system for expanding search criteria capable of removing duplicated data from the messages (paragraph 57). It would have been obvious to one of the ordinary skill in the art during the time the invention was made to incorporate Rios's teaching about removing duplicated items into Chappelle's conversion program because the duplication is burdensome and it requires a user to review each retrieved result, and this in fact requires more storage space.

9. Claims 8, 9, 17, 26, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) in the view of Gruen et al (US Publication 2005/0057584).

As to claims 8, 17 and 26, Chappelle teaches all the limitations except for the compilation means being operable to identify e-mail messages (instant messages) in the database having content relating to common subject matter for inclusion in the subset, Chappelle also does not teach that the artificial intelligence is used to reach this goal. Gruen teaches a calendar bar interface for electronic mail interaction being

capable of updating summarized electronic mail with related to its content messages (paragraph 71). Furthermore, in order to perform collection of related information, Gruen inherently uses artificial intelligence because the software that makes the comparisons has to decide about the relevance of the message. It would have been obvious to one of the ordinary skill in the art during the time the invention was made to use Gruen's teaching about finding related material and incorporate it into the Chappelle's conversion program, because this would allow to collect a complete set of messages about specific topic wherein the complete context would be more helpful to a user than incomplete messages.

As to claim 9, Chappelle teaches an apparatus wherein the compilation means are further operable to remove header information from e-mail messages then producing the compilation (column 7, lines 36-38).

As to claim 30, Chappelle teaches compilation means however he does not teach that the compilation automatically updated when the user sends or receives further digital communications. Gruen teaches the electronic mail interaction wherein the program can automatically sort incoming mail based on defined criteria (paragraph 91). It would have been obvious to one of the ordinary skill in the art during the time the invention was made to make a use of Gruen's teaching about automatic updating of the incoming emails because this allows the user to collect all the information regarding certain issue. Furthermore as Gruen shows, the emails can be sorted based on their urgency, this in fact would allow the user to answer to important emails relatively fast (with priority).

As to claim 31, Chappelle nor Gruen teaches that a specific digital communication can be added or removed from the compilation, and wherein the compilation means are operable to add or remove the specific digital communication to or from the compilation. Gruen teaches however, that the messages can be automatically removed from the inbox and moved to different location (so his software is capable of removing designated messages), similarly it would have been obvious to one of the ordinary skill in the art during the time the invention was made to allow adding or deleting messages from the compilation of emails because this would prevent the compilation to reach the maximum storage limitation and it would also allow the user to have a greater control over stored data.

10. Claims 13, 14, 18-20, 23, 24, 29, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976).

As to claim 13, Chappelle teaches the apparatus wherein messages are of a type selected from a group comprising: text messages sent to or from computer; picture messages sent to or from computer; multimedia clips sent to or from computer; data file sent to or from computer. Chappelle does not teach that the computer is a mobile station however it would have been obvious to one of the ordinary skill in the art during the time the invention was made that the computer can be also a mobile computer, in other words laptop, which in fact is a mobile device.

As to claim 14, Chappelle teaches an apparatus wherein the database is a mobile telecommunication messaging server (Figure 5, element 506; GIF database is designed to be remotely accessed by at least one user, (column 12, lines 37-40).

Chappelle does not explicitly state that the database should be stored on the server, however it would have been obvious to store this database on the server because this would allow multiple users to login and access data when needed, and this in fact would create a robust system.

As to claim 18, Chappelle teaches an apparatus incorporated in a server (Figure 5, element 506) in communication with mobile telecommunication messaging server (Figure 5, element 508).

As to claim 19, Chappelle teaches an apparatus operable to transmit the compilation to the user's mobile station (column 8, lines 1-4; as mentioned above it would have been obvious that a user could use laptop instead of regular personal computer).

As to claim 20, Chappelle teaches sharing the stored compilation among users, who can access the database from remote computers. He does not however state specifically that the webserver is used to store the compilation. It would have been obvious to one of the ordinary skill in the art during the time the invention was made to use webserver to store the compilation because this a common way of storing data which allows multiple users to access it at any time.

As to claim 23, Chappelle teaches the system wherein the central site receives electronic messages from the remote computers. He does not specifically teaches that the database of the messages is stored on the user's personal computer. It would have been obvious to one of the ordinary skill in the art during the time the invention was made to store at least sent email messages on the user's personal computer because

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majority of software programs supporting e-mails (for instance Microsoft Outlook) save sent messages inside the sent messages box, so the user can access them in the future if needed.

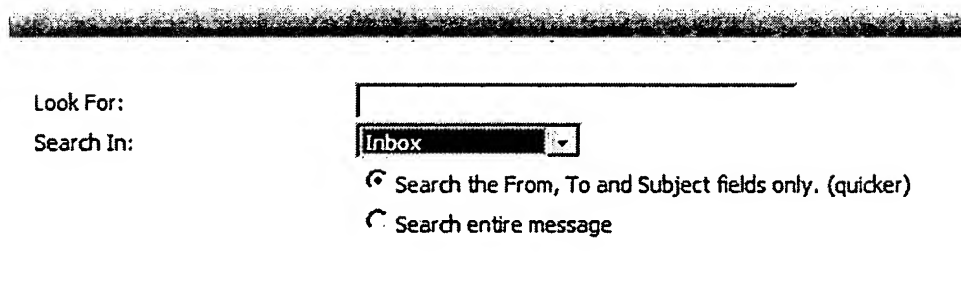
As to claim 24, Chappelle teaches all the limitations as disclosed in claim 22, however he does not explicitly state that the database of emails is stored on a server. Chappelle teaches though that the central collection has software, which allows editing of the electronic mail into specific format. It would have been obvious to one of the ordinary skill in the art during the time the invention was made to have the database of electronic messages stored on the server because it is obvious to make a central database a server, so the remote computers can access it. Furthermore since the central unit needs to use electronic messages for editing, it would also have been obvious to store those messages at the server, so the processing time of accessing the relevant text would be shorter. This in fact would shorten compilation time, and make system more efficient.

As to claim 29, Chappelle does not explicitly teach that the result of the compilation can be printed out, however he teaches that the accessing of the graphic data is done on a computer (column 8, lines 31-40) and therefore it would have been obvious to one of the ordinary skill in the art during the time the invention was made, that the computer connected to the printer is capable of printing an application or a file).

As to claims 33 and 34, Chappelle discloses the computer program comprising an e-mail client because the compilation program accesses emails (instant messaging since email is capable of being used as instant messenger) in order to edit them and

them to the compilation (column 7, lines 35-41). Chappelle does not explicitly state that the email client software is integrated with the compilation program, however since the email client software and the compilation software are installed on the same machine they can be considered integrated.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) in the view of MSN Hotmail. Chappelle teaches all the limitations disclosed in claim 13, however he does not teach that the input means are operable to receive the interrogation criterion via the Internet. MSN Hotmail teaches entering interrogation criteria via Internet. It would have been obvious to one of the ordinary skill in the art during the time the invention was made to use the searching feature allowing entering a keyword via Internet as taught by MSN Hotmail because this would allow a user to search email database without having software installed on the personal computer, and in fact this would allow for smaller hard drive space use.



12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) in the view of Medoff (US Publication 2003/0088517). Chappelle teaches all the limitations disclosed in claim 20, but he does not teach that the apparatus is operable to send the user access details to enable the user to access

the compilation stored on the webserver. Medoff teaches a system wherein the password is sent out to the user so that this person can access the information (paragraph 7) saved on the webserver. It would be obvious to one of ordinary skill in the art during the time the invention was made to use the password to allow specific users to access the compilation as taught by Medoff and incorporate it in Chappelle's access system because it would allow to control who is authorized to see the compilation for instance only family and friends.

13. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) and Kawell, JR. et al (US Publication 2005/0165726) and further in the view of Rios et al (US Publication 2002/0194162). Chappelle and Kawell teach all the limitations disclosed in claim 37, they do not teach however the compilation means being operable to remove duplicated content from messages for inclusion in the subset. Rios teaches a method and system for expanding search criteria capable of removing duplicated data from the messages (paragraph 57). It would have been obvious to one of ordinary skill in the art during the time the invention was made to incorporate Rios's teaching about removing duplicated items into the combination of Chappelle's and Kawell's conversion program because the duplication is burdensome and it requires a user to review each retrieved result, and this in fact requires more storage space.

14. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chappelle (US Patent 5949976) and Kawell, JR. et al (US Publication 2005/0165726)

and further in the view of Rios et al (US Publication 2002/0194162), and further in the view of Gruen et al (US Publication 2005/0057584).

As to claim 39, Chappelle, Kawell and Rios teach all the limitations disclosed in claim 38, however none of them teaches generating a compilation including the step of opening attachments and incorporating opened attachments in the scrapbook document. Gruen teaches the electronic mail interaction wherein the compilation (meta data) may include attachments (paragraph 51). Since the Gruen's meta data should show the summary of the electronic messages it would have been obvious to have opened attachment along with the text because just an attachment name would not be very informative for the user and it would take an additional time to open up and therefore it would be inefficient. Furthermore it would have been obvious to one of ordinary skill in the art during the time the invention was made to incorporate Gruen's teaching about including attachment within the compilation, into the invention as disclosed in claim 38, because some of the important information might be contained in the attachment for instance word document containing important facts. Placing the opened attachment in the compilation would be more convenient for the user because all the information would be in one document.

As to claim 40, Chappelle teaches the method wherein the result set includes messages sent by plurality of people (column 3, lines 7-9; since there is at least one production computer, there will be multiple numbers of emails, i.e. plurality of people (the users of those computers)).

As to claim 41, Chappelle teaches the method wherein the result set includes messages sent by the user (column 3, lines 7-9, wherein the person operating the remote computer from which the data is collected via the email, is a user of this computer).

Inquiry

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela M. Lie whose telephone number is 571-272-8445. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Angela M Lie

